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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/758,648	01/10/2001	Larry Lunetta	004565.P001	9518
7590 07/29/2004				
Andre L. Marais BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP 7th Floor 12400 Wilshire Boulevard Los Angeles, CA 90025			EXAMINER PATEL, KANJIBHAI B	
			ART UNIT	PAPER NUMBER
			2625	
DATE MAILED: 07/29/2004				

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Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/758,648

Applicant(s)

LUNETTA ET AL.

Examiner

Kanji Patel

Art Unit

2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-69 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 64-69 is/are allowed.
- 6) ☒ Claim(s) 1-5, 16-25, 32-38, 42-46, 50-52, 55-59, 62 and 63 is/are rejected.
- 7) ☒ Claim(s) 6-15, 26-31, 39-41, 47-49, 53-54, 60-61 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

***Response to Amendment***

1. The Declaration filed on 5/4/04 (Paper No. 7) under 37 CFR 1.131 is sufficient to overcome the Knight reference. A new ground of rejection has been established as follow.

2. ***Claim Rejections - 35 USC § 102***

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 1-5, 16-25, 32-38, 42-46, 50-52, 55-59 and 62-63** are rejected under 35 U.S.C. 102(e) as being anticipated by Halliday et al. (hereinafter referred to as Halliday) (US 5,880,740).

**For claim 1**, Halliday discloses a method for generating a composite image including (at least figures 10-11):

presenting a first image (column 7, lines 50-54; in individual image can provide a first image; in figures 1-6, zones 13, 15, 18, 31 correspond to a first image) via a Web interface (in figures 10-11, 107, 108, 105, 225 provide web interface) presented on a browser (workstation 101 in figure 10 or 225 in figure 11 provides web browser);

presenting a second image (column 7, lines 50-54; in figures 1-6, background images 11, 21 can provide a second image) via a web interface (in figures 10-11, 107, 109, 105, 225 provide web interface) presented on the browser (workstation 103 in figure 10 and 225 in figure 11 provides a web browser);

communicating (internet 105 is used for communication between server and clients) a selection of the first image (13, 15, 31) and the second image (11, 21) to a server (155, 157) via a network (105 in figure 10 provides internet);

automatically generating a composite image (158, 208) of the first image and the second image at the server (158 in figure 10 and 208 in figure 11 provides program for image composition and manipulation automatically); and

communicating (105, 107, 109) the composite image (figures 1-6; 158, 208) from the server (155, 157) to the browser (101, 103, 225) via the network (105).

**For claim 34, 50 and 57,** see the rejection of claim 1 above.

**For claims 2, 22, 35, 43, 51, 58,** Halliday discloses the method wherein the first image is a product image (column 7, lines 39-43; column 9, line 53-57; digital postcard is a product image).

**For claims 3, 23, 36, 44, 52 and 59,** Halliday discloses the method wherein the second image is a decorative image including any one of a group of images including a logo image and a text image (in figures 1-6, a graphic image zone 15 or 18 or 31 corresponds to a decorative image).

**For claims 4, 24, 37 and 45,** Halliday discloses the method wherein the composite image includes the second image placed in a default position on the first image ( in figures 1-6, a rectangular image in lateral direction provides default position for the second image i.e. for background image and a mouse can be used to adjust the position).

**For claims 5 and 25,** Halliday discloses the method further including:

positioning (figures 1-6; the second image is a background image) the second image relative to the first image (in figures 1-6, graphic zone or text zone can provide a first image) via a Web interface (figures 10-11 provides web interface) presented on the browser to generate relative positioning information (see also column 3, lines 1-37);

communicating the relative positioning information to the server (155, 157) via the network (105);

automatically generating the composite image (208) of the first image (13, 15, 18) and the second image (11, 21) at the server according to the relative positioning information (figures 10-11).

**For claim 16 and 32,** Halliday discloses the method wherein the composite image is associated with information in a database (103, 115, 204, 206), the associated information in the database being communicated together with the composite image from the server to the browser via the network as a photo sample (column 9, lines 53-57).

**For claims 17 and 33,** Halliday discloses the method wherein the photo sample is sent via network to a specified e-mail address (212 in figure 11).

**For claim 18,** Halliday discloses the method wherein a URL containing the photo sample is sent via network to a specified e-mail address (212 in figure 11; figures 8-9).

**For claim 19,** Halliday discloses the method wherein a user zooms (column 3, lines 38-46) in to the photo sample.

**For claim 20,** Halliday discloses the method wherein a user zooms out of the photo sample (column 3, lines 38-46).

**For claim 21**, see the rejection of at least claim 1 above.

**For claims 38 and 46**, Halliday discloses the network-based method further including: positioning the second image relative to the first image via a Web interface (figure 10-11) presented on the browser (225 in figure 11) to generate a relative positioning information (column 3, line 2); communicating the relative positioning information to the server via the network (105 in figure 10); receiving the composite image (208 in figure 11) of the first image (column 1, lines 58-67; individual image elements are used for the first image and second image to create a composite image) and the second image from the server to the browser, the composite image generated according to the relative positioning information (input device mouse is used for positioning information); and displaying the composite image at the browser (at least 121 in figure 10 is a display).

**For claim 42**, see the rejection of at least claim 1 above.

**For claims 55 and 62**, Halliday discloses the apparatus wherein the server is further configured to generate a photo sample (figures 1-6).

**For claims 56 and 63**, Halliday discloses the apparatus wherein the server is further configured to transmit the photo sample via the network to a specified e-mail address (108, 110, 212).

***Allowable Subject Matter***

3. **Claims 6-15, 26-31, 39-41, 47-49, 53-54 and 60-61** objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

**Claims 64-69** are allowed.

**For independent claim 64**, the prior art on record fails to teach or suggest, alone or in combination for automatically calculating an embroidery price of the composite image, the embroidery price comprising an estimated price for the application of a design represented by the second image to a product represented by the first image and communicating the composite image along with the calculated embroidery price from the server to the browser via the network.

**Contact information**

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Kanji Patel** whose telephone number is (703) 305-4011. The examiner can normally be reached on Monday through Friday from 8:00 a.m. to 6:30 p.m. Friday off.

If attempts to reach the examiner by phone are unsuccessful, the examiner's supervisor, **Mehta, Bhavesh**, can be reached on (703) 308-5246.

Any inquiry of general nature or relating to the status of this application should be directed to the **Group receptionist** whose telephone number is (703) 305-3800.

The **Fax number** for this group is (703) 306-9306.



Kanji Patel  
Patent Examiner  
Group Art Unit 2625  
July 23, 2004